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REMARKS

In response to the second ("final") Office action mail-dated 22 September 2004, reconsideration of the application, as amended, is respectfully requested.

Applicant's response to the Office action mail-dated 08/25/03 includes the instant *After-Final Amendment* and a *Request to Vacate Final Rejection*. Also being concurrently filed herewith is a *Petition for Extension of Time under 37 CFR 1.136(a)*. A *Notice of Appeal* was filed by Applicant on 12/21/04. The Office is respectfully requested to charge any fees as may be required, and to credit any overpayment, to Deposit Account No. 50-0958.

By Applicant's accompanying *Request to Vacate Final Rejection*, Applicant respectfully requests that the Office withdraw the finality of the Office action mail-dated 09/22/04. It is therefore respectfully urged that, as of right upon the vacating of the 09/22/04 final rejection, the amendments proposed herein should be entered and the application as amended hereby should be considered. "When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered." MPEP 706.07(e)

By the instant *After-Final Amendment*, Applicant proposes to amend independent claims 1, 6, 19 and 29. Assuming entry of all of the claim amendments, claims 1-33 remain in the application.

Applicant respectfully urges that the claims as amendedly presented herein are allowable. While Applicant believes that claims 1-33 as they exist in the absence of the instantly proposed amendments are also allowable, Applicant believes that the instant amendments even further distance Applicant's claimed invention from the cited

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art. Applicant is encouraged in this regard by discussions that took place during the 03/04/05 telephonic interview in which Examiner Vanel Frenel, Examiner Joseph Thomas and the Attorney Howard Kaiser (the undersigned) participated. During the 03/04/05 telephonic interview, Examiner Thomas manifested receptiveness to certain claim limitations, previously unrecited, that were similar to claim limitations that are being instantly presented in independent claims 1, 19 and 29.

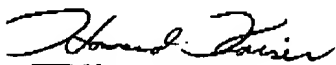
Claim 6 is amended to recite "internal" instead of the inadvertent "external."

Support for amendments herein may be found in Applicant's specification at, e.g., page 9, line 11 to page 10, line 1; page 36, line 7 to page 37, line 14; page 38, line 7 to page 39, line 6; see also, Appendices B and C of Applicant's disclosure.

In view of the foregoing, Applicant respectfully requests entry of the instant claim amendments, and further respectfully requests allowance of claims 1-33.

The Examiner should please feel free to contact the undersigned at telephone number 301-227-1834 to discuss any questions concerning this matter.

Respectfully submitted,



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03/20/05
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20 March 2005

MAR 20 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: : Confirm. No.: 8767
GLENN G. WARD, DONALD J. COLLINS and :
RICHARD A. STUTCHFIELD :
Serial No.: 09/671,871 : Art Unit: 3626
Filing Date: 09/28/00 :
Attorney Docket No.: 82,144 :
Title: OPERATING PLAN FOR MACHINERY : Examiner: Vanel Frenel

REQUEST TO VACATE FINAL REJECTION

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This paper and the accompanying *After-Final Amendment* are responsive to the second Office action, mail-dated 09/22/04, and are pursuant to 37 CFR 1.116 and 37 CFR 1.121.

Applicant's response to the Office action mail-dated 08/25/03 includes the instant *Request to Vacate Final Rejection* and an *Amendment* under 37 CFR 1.116. A *Notice of Appeal* was filed by Applicant on 12/21/04. The Office is respectfully requested to charge any fees as may be required, and to credit any overpayment, to Deposit Account No. 50-0958.

Certificate of Facsimile Transmission under 37 CFR 1.8

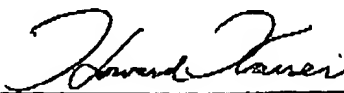
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 703-872-9306)

on Sunday, March 20, 2005.

Typed or printed name of person signing this certificate

Howard Kaiser

Signature



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Applicant respectfully requests withdrawal of the finality of said second Office action mail-dated 09/22/04, deemed "final" by the Office.

Applicant bases the instant request for withdrawal of finality on the incompleteness and/or inadequacy of the 08/25/03 Office action. In particular, the Office has failed to meet its obligation to substantiate a claim rejection as to every limitation in the claim.

By way of explanation, the instant application was filed on 28 September 2000 with thirty-three claims (claims 1-33).

By the first Office action, dated 17 February 2004, the following rejections were rendered: (1) Claims 1-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter; and, (2) Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al. U.S. Pat. 5,189,606 in view of Kennedy U.S. Pat. 5,845,258.

Applicant's Amendment filed 10 June 2004 amended claims 1, 10, 11, 16-29 and 33.

The second Office action, dated 22 September 2004 and deemed final, withdraws the aforesaid rejections under 35 U.S.C. 101 and 35 U.S.C. 103(a) and rejects claims 1-33 as amended by Applicant's Amendment filed 10 June 2004. By the second Office action, the following rejection is rendered of claims 1-33 as amended by Applicant's Amendment filed 10 June 2004: Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. U.S. Patent No. 6,578,006 in view of Summers U.S. Patent No. 6,408,263.

Accordingly, the second Office action withdraws all previous rejections and renders a new ground of rejection under 35 U.S.C.

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103(a). In fact, the second Office action characterizes its action thusly in its paragraph 4 (pp 13-14). This new ground rejection applied entirely new references, viz., Saito et al. and Summers, which were cited for the first time via the Office's "Notice of References Cited" that was attached to the second Office action.

As to independent claims 1, 19 and 29, the second Office action discussed its rejection under 35 U.S.C. 103(a) as being unpatentable over Saito et al. in view of Summers in the following locations:

independent claim 1: second Office action, paragraph 3, subparagraph "(A)" (pp 2-3)

independent claim 19: second Office action, paragraph 3, subparagraph "(S)" (pp 7-9)

independent claim 29: second Office action, paragraph 3, subparagraph "(BB)" (pp 11-12)

With regard to each of independent claims 1, 19 and 29, the second Office action discusses only the limitations that were added by Applicant's 06/10/04 Amendment, i.e., the previously unrecited limitations only. Each of the above-listed subparagraphs began, "As per the added features to claim [1 or 19 or 29],..."

Accordingly, the second Office action failed to meet its obligation to support its claim rejection under 35 U.S.C. 103(a), as to each claim so rejected, as to every limitation in the claim.

Instructive is MPEP 706.02(j), entitled "Contents of a 35 U.S.C. 103 Rejection," wherein the following is stated, citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991): "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary

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skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." [bold emphasis added herein] These principles are well settled regarding obviousness rejections under 35 U.S.C. 103.

The Office action erroneously addresses only the newly added limitations in independent claims 1, 19 and 29. By failing to treat all of the limitations of the rejected claims, the Office action is per se deficient in explaining its rejections. Because the first Office action rendered a 35 U.S.C. 103 rejection that is entirely different from that which is rendered by the second Office action -- especially insofar as applying entirely different art -- it is irrelevant that the first Office action treated the previously existing limitations. Since the Office has retreated from its previous 35 U.S.C. 103 rejection and has rendered an entirely new 35 U.S.C. 103 rejection, with entirely new art, it is incumbent upon to Office to fully support this new ground rejection by addressing all of the claim limitations.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found **the claimed invention** to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), cited by MPEP 706.02(j).

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While one can only speculate as to the Office's thought processes appertaining to the second Office action's 35 U.S.C. 103(a) rejection, it is possible that the Office has erroneously considered the previously existing claim limitations to have been addressed in the first Office action, albeit the first Office action rendered entirely different rejections with entirely different applied art. As to the present 35 U.S.C. 103(a) rejection, the Office cannot rely on any arguments that it made relative to the previous 35 U.S.C. 103(a) rejection, which is now "moot." Indeed, the term "moot" is used, in paragraph 4 of the second Office action, to describe the first Office action's 35 U.S.C. 103(a) rejection. "Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." MPEP 706.02(j), citing *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

Accordingly, Applicant respectfully requests that the Office withdraw the finality of the Office action mail-dated 08/25/03.

Applicant respectfully requests that the Office enter the amendments proposed by the accompanying *After-Final Amendment*, and reconsider the application as amended thereby. "When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered." MPEP 706.07(e).

Respectfully submitted,



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